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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN PAUL MARCADE, ANTHONY WEST, and
FREDERICK W. KORNAHRENS

Appeal 2007-2500
Application 09/777,274
Technology Center 3700

Decided: December 29, 2008

Before WILLIAM F. PATE, III, HUBERT C. LORIN, and ANTON W.
FETTING, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This is a response to Appellants' Request for Reconsideration filed on Nov. 26, 2007 pursuant to 37 C.F.R. § 41.52(a)(1) (2007). Such Requests must state with particularity points believed to have been misapprehended or overlooked by the Panel in rendering the Decision.

Appellants' first point raised in the Request is that the Board has offered too narrow a construction of the claim term "configured to mate." Although we are familiar with the argument that we have erred in construing a claim term, it is rare that we see an argument that the Board has construed a claim term too narrowly.

The Appellants agree with our construction of the "configured" portion of the term as formed or shaped, but Appellants do not agree that "to mate" should be construed as having the same shape and diameter. Curiously, while arguing our construction of the term is too broad, Appellants have yet to offer a construction of the entire term "configured to mate" even up to and including in the Request, since they never construe the claim term "mate." We were and are of the view that "mate" when used in this context should be construed as fitting together. Thus, we agree with Appellants that our claim construction advanced in the opinion, if construed to mean *exactly* the same shape and diameter, is overly narrow, inasmuch as it is clear that extender 114 is configured to be received or alternatively receives first leg 132 (see claims 71 and 72 and Appellants' description of the claimed subject matter at Br. 4:1-2). Accordingly, with an abundance of caution, we reconsider our construction of the claim term "configured to mate" and change our construction of the term to the *broad*er "shaped or formed to interfit or fit together." Admittedly, we are at a loss as to how this *broad*er claim construction helps the Appellants' case.

Additionally, as we mentioned in our decision, the expression "configured to mate" only describes the extender, and there is no

requirement in claim 67 that the extender be introduced into the vasculature or actually mated with the body. Only the body is stated as having been emplaced.

Next Appellants argue our inference that short tube graft 8 of Martin has the same general diameter as straight tube graft or extender 18 of Martin. We agree that the written disclosure of Martin does not affirmatively state that these two components are of the similar diameters and shapes. Notwithstanding this fact, it remains our finding that Martin anticipates Appellants' claim 67 as we found in our original decision and for an additional reason based on our new and broader claim construction advanced above.

In our Decision, we referred to Figure 5 as showing that short tube graft 8 and straight tube graft or extender 18 are fitted together. We concur in that finding and reiterate that the Figure teaches that these parts fit together for blood flow. Appellants do not argue that this is not the case. Under our new claim construction it can be seen that parts that fit together anticipate Appellants' claim element of "configured to mate." Secondly, the disclosure states that the straight tube graft 18 overlaps the short tube graft 8 and that the straight tube graft 18 may be expanded into position, presumably by a balloon catheter. See Martin at col. 4, ll. 15-19. This is another indication that these grafts are "configured to mate" as required by the claimed subject matter, since these two grafts are formed to fit together.

With respect to the Appellants' argument that the extender is configured to mate with the longer leg of the body, we agree that this is what the claim requires, and we have two responses thereto. First of all, Martin gives a range of lengths for both the distance from the bottom end 6 to the

opening 7 and for the length of the short tube graft 8. While both of these are disclosed as preferably 1 cm, Martin does contemplate a range of length for both of these features of from 0.5 cm to 1.5 cm. Martin does not state that these lengths are related or have to be the same. Thus, Martin does contemplate that the length of short tube graft 8 might, in some instances, be longer than that length which terminates in the opening 6, thus making short tube graft 8 the longer leg. In this situation, the straight tube graft 18 is certainly configured to mate with the longer leg 8 thus satisfying the claimed limitation.

Secondly, as we discussed in our prior decision, there is an overlap of size ranges between the opening 6 and the opening 7 of Martin. Opening 6 has a diameter of 4 to 6 mm, col. 2, l. 63. Opening 7 has a diameter of 4 to 8 mm. See col. 2, l. 66. Inasmuch as we have previously found that straight tube graft 18 is sized so as to be configured to mate with short tube graft 8, at least for some contemplated sizes of opening 6 and short tube graft 8, straight tube graft 18 is the same dimension as the opening 6. Note that the claim never requires these two pieces--opening 6 and straight graft 18--to be connected, only that they be “configured to mate.” Thus it was our finding that the claimed subject matter of claim 67 lacked novelty over the Martin reference. We note that this is additionally true to the extent that straight tube graft 18 could be placed in opening 6 and expanded by balloon catheter to fill and seal the opening.

Appellants point to the “overlap” terminology of Martin, while we agree that Martin does state that short tube graft 8 and straight graft 18 overlap, this refers to the linear disposition or axial extent. The two tubes

overlap so that the graft 18 may be expanded to fit in the straight tube graft and common femoral artery when expanded.

Finally, Appellants argue that there are structural differences between the end opening 6 and the straight graft tube 18. As we reiterated above, the claim does not require the installation of the extender in the longer leg, only that these structure be somehow “configured to mate.” Here is where Appellants’ broader claim construction lets them down. As we have detailed above, these structures of Martin would certainly “fit,” i.e., dimensionally. Their actual use together is not required in claim 67. And while Appellants argue that a stented straight tube graft 18 could not be placed in a stented opening 6, which has not be established on this record, whether these parts are stented or not is immaterial as they are not required to actually be mated by the claimed subject matter.

For the reasons given above, our prior decision has been reconsidered and granted to the extent that we have broadened our claim construction of the expression “configured to mate” in claim 67. With respect to making any further changes in our Decision the Request is denied.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2007).

GRANTED-IN-PART

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